

### REMARKS/ARGUMENTS

Favorable reconsideration of this application, in light of the present amendments and following discussion, is respectfully requested.

Claims 1-13 and 15-20 are pending; Claims 1-13 are presently active; Claims 1-13 are amended; and no claims are newly added or canceled herewith. It is respectfully submitted that no new matter is added by this amendment.

In the outstanding Office Action, Claims 1-7 and 10-13 were rejected under 35 U.S.C. § 103(a) as unpatentable over Okada et al. (EP 0843380, hereafter Okada) in view of Emura (U.S. Pat. No. 5,424,864) and further in view of Sano (U.S. Pat. No. 5,697,083); and Claims 8 and 9 were rejected under 35 U.S.C. § 103(a) as unpatentable over Okada in view of Emura and Sano and further in view of Taruki et al. (JP 09-215047, hereafter Taruki).

At the outset, Applicants respectfully request acknowledgement of the Information Disclosure Statement filed December 12, 2000. A copy of the papers as filed, including the date stamped filing receipt, is provided herewith.

In response to the rejection of Claims 1-7 and 10-13 as unpatentable over the combination of Okada, Emura, and Sano, Claims 1 and 2, from which Claims 3-7 and 10-13 have been amended herewith.

Claim 1, as amended, recites “a combiner unit configured to combine the weighted signals; and a received signal generation unit configured to demodulate the combined signals to generate a received signal.” Through the claimed configuration, the cost and size of the base station, control station, and transmitter is reduced.<sup>1</sup>

These features of Claim 1 are not taught or suggested by the applied combination of Okada, Emura, and Sano. Accordingly, it is respectfully submitted that Claims 1, 3, 5, 7-10, and 13 patentably distinguish over the applied combination. Moreover, it is respectfully

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<sup>1</sup> Specification, pages 5-6.

submitted that there is no basis in the teachings of any of Okada, Emura, or Sano to support this combination. Certainly, the Office Action does not cite to any specific teachings in any of these references to provide motivation for the allegedly obvious combination. As a result, it is respectfully submitted that the combination of Okada, Emura, and Sano is the result of hindsight reconstruction based on the teachings of the present specification, and is improper.

With respect to the features of Claim 2, Claim 2 recites, in part, “a weighting unit configured to weight .... the transmitted signal.”

The outstanding Office Action alleges that the combination of Okada and Emura discloses all of the features of Claim 2. However, at page 5 of the outstanding Office Action, the Office Action admits that the combination of Okada and Emura does not disclose or suggest a weighting unit, as recited in Claim 2. Accordingly, based on the admission in the outstanding Office Action, it is respectfully submitted that the applied combination of Okada and Emura cannot render obvious the features of Claim 2.

Moreover, as set forth in MPEP § 2143, the mere fact that references can be combined and modified does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680 (Fed. Cir. 1990). Additionally, although a prior art device may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so. Id. at 682. As the outstanding Office Action does not cite to any teachings within any of the applied references to support the combination of Okada and Emura, it is respectfully submitted that the combination of Okada and Emura is the result of hindsight reconstruction in view of the present specification. Thus, as the outstanding Office Action has violated the requirements of a *prima facie* case of obviousness as set forth in MPEP § 2143, it is respectfully requested that the rejection of Claims 1-7 and 10-13 be withdrawn.

With respect to the remaining rejections under 35 U.S.C. § 103(a), the combination of Okada, Emura, Sano, and Taruki is deficient for at least the reasons set forth with respect to the combination of Okada and Emura above. Additionally, the Office Action has not cited to any teachings in Sano or Taruki that might provide motivation for this allegedly obvious combination. Absent any motivation in the references themselves, it is respectfully submitted that the combination of Okada, Emura, Sano, and Taruki is the result of hindsight reconstruction in view of the present specification, and is improper.

Accordingly, it is respectfully submitted that the outstanding Office Action has also failed to provide a *prima facie* case of obviousness with respect to Claims 8 and 9, and it is respectfully requested that this rejection be withdrawn.

Consequently, in view of the foregoing discussion and present amendments, it is respectfully submitted that this application is now in condition for allowance. An early and favorable action is therefore respectfully requested.

Respectfully submitted,

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